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EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
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2168

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/490,061

Applicant(s)

KAWAOKA, YOSHIKI

Examiner

HUNG Q. PHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 7-26 are pending. This action is non-final in view of new grounds of rejections under 35 U.S.C. § 101 and 112.

Response to Arguments

- Claim Rejections - 35 USC § 112

The rejection of claims 14 and 18 under 35 U.S.C. § 112, first paragraph, has been withdrawn in view of the amendment.

- Claim Rejections - 35 USC § 103

Applicants' arguments with respect to the rejection of claims 7-24 under 35 U.S.C. § 103 have been fully considered but they are not persuasive.

- As argued by applicants with respect to claims 7 and 10:

(1) at pages 9 and 10:

... claim 7 is amended to recite that the last file-number is read out from the second loadable and recording medium. In contrast, as the Examiner fully recognizes, the reception number is read from the internal counter, NOT from the disk device where the image files are recorded. In other words, Shiota cannot teach or suggest the feature of "a file-number readout device configured to read out a last file-number of file-numbers for image files that have been recorded on the second loadable and removable recording medium from the second loadable and recording medium" as recited. This is sufficient to distinguish claim 7 over Shiota.

(2) at page 11:

... there is simply no guarantee that the resulting file name will be different from all file names currently in the CD.

As an example, there may be a file with the name "flower04030010001" in the CD already. If the counter number is 0009 in the laboratory system and the image file in the memory card has "flower" as the subject and "0403" as the date, then according to Shiota, the counter number will be

incremented to 0010 and the resulting file name will be "flower04030010001." This is identical to the file already recorded in the CD. Thus, simply replacing the hard disk drive of the system disclosed in Shiota with a loadable and removable disc as suggested by the Examiner cannot guarantee unique file naming, i.e. the suggested modification renders Shiota unsatisfactory for its intended purpose. Then by definition, there is no motivation to make the modification. Accordingly, the Section 103 rejection fails with respect to claim 7.

Examiner respectfully disagrees.

(1) As recited in claim 1,

a file-number readout device to read out a last file-number of file-numbers for image files that have been recorded on the second loadable and removable recording medium from the second loadable and recording medium;

This claimed limitation is interpreted as *a last file-number of file-numbers is read out, wherein image files that have been recorded on the second loadable and removable recording medium and file-numbers are from the second loadable and recording medium.*

As disclosed by Shiota, if the method is carried out by a system in a laboratory rather than a personal computer, a counter is used for counting a 4 digits reception number. Every time one memory card is accepted, the counter is incremented and the identifying number is assigned by a combination of the reception number and a serial number, e.g., if "flower04030001001" to "flower040300010010" are from the first memory card, the first file name of the second memory card is "flower04030002001" (Col. 7, Lines 18-35). As seen, when the first memory card accepted, the previous reception number was 0000 and the counter incremented 0000 by one to have 0001 as the reception number for the first memory card. In order to have the reception number for the second memory card, e.g., 0002, the counter retrieves the previous reception number, e.g., 0001; and increments by one. Thus, the previous reception number, e.g., 0001, as *a last file number of "flower04030001001" to*

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"flower040300010010" as *file-numbers* is read out and incremented, and these *file numbers* concerning (for) *image files that have been recorded on the second recording medium, e.g.,* "flower04030001001" to "flower04030001010", and these *file numbers are from the second loadable and recording medium*. In short, the Shiota discloses the claimed limitation *reading out a last file-number of file-numbers for image files that have been recorded on the second recording medium from the second loadable and recording medium*.

(2) Applicants' arguments with respect to the unique file naming have been fully considered, and the examiner does not guarantee a response to these arguments (features are not in the claim). However, in order to clarify these arguments, examiner respectfully points out that the example as provided is not realistic, because if the name "*flower04030010001*" is in the CD, the counter number must be 0010, and if the image file is in the same memory card the next file name will be "*flower04030010002*", and if the image file in from the other memory card, the file name will be "*flower04030011001*". There will be no duplicate file names in Shiota method.

- Claims 8, 9 and 11-24 depend from independent claims 1 and 10 directly or indirectly. Therefore, for at least due to the dependency thereon, these dependent claims are not distinguishable over Shiota.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the

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following is required: *file-number readout device, incrementing device, image-file recording controller and grouping device* as recited in claims 7-9.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-9, 13-16, 21, 23 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7-9, 13-16, 21, 23 and 25 direct to a system. However, the system of claims 7-9, 13-16, 21, 23 and 25 comprises software per se. Software per se is not one of the four categories of invention. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine or manufacture. Software per se is not a combination of substances and therefore is not a composition of matter. Therefore claims 7-9, 13-16, 21, 23 and 25 are not statutory.

Claims 7-26 are directed an apparatus and method of recording image file on a second loadable and removable recording medium. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful and tangible result. Specifically, the claimed subject matter does not produce a useful result because the claimed subject matter fails to sufficiently reflect at least one practical utility set forth in the descriptive portion of the specification. More specifically, while the described practical utility (utilities) is (are) directed to

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unique file naming, the claimed subject matter relates ONLY to recording the image file regardless of the change of file name (as recited in claims 7 and 10, only the image file is recorded). Additionally, the claimed subject matter does not produce a concrete result because the claimed subject matter fails to be limited to the production of an assured, repeatable result. More specifically, the claimed subject matter is not repeatable if the second loadable and recording medium is blank (no image files have been recorded). In this particular case (no image files have been recorded), the file number cannot be read out and the steps incrementing the file number and changing the file name will not be implemented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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As in claims 23 and 24, the claimed limitation, *the numerical characters of the file name is unique to each image file stored in the second loadable and recording medium*, was not described in the specification¹.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As in claims 7 and 10,

the clause, *from the second loadable and recording medium* (at lines 7-8 of claim 7 and lines 6-7 of claim 10), references to other items in the claims. It is unclear what item is being referenced;

the clause, *the read image file* (at line 14 of claim 7 and line 11 of claim 10), references to other items in the claims. It is unclear what item is being referenced.

¹ *the numerical characters of the file name* references to the file name of image file from the first medium, and this file name

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. [EP 0 838 767 A2] in view of Ahrens et al. [The big Basics Book of Windows 95].

Regarding claims 7 and 10, Shiota teaches a method and device for *reading out an image file that has been recorded on a first loadable and removable recording medium and recording said image file on a second recording medium* (Shiota, Col. 1, Lines 6-15), comprising the steps of:

reading out a last file-number of file-numbers for image files that have been recorded on the second recording medium from the second loadable and recording medium, and incrementing the read out last file-number (As illustrated at Col. 7, Lines 18-35, a laboratory system implies *a second recording medium* is included in the system. As illustrated at Col. 7, Lines 18-35, if the method is carried out by a system in a laboratory rather than a personal computer, a counter is used for counting a reception number. Every time one memory card is accepted, the counter is incremented and the identifying number is assigned by a combination of the reception number and a serial number, e.g., if "flower04030001001" to "flower040300010010" are from the first memory card, the first file name of the second memory card is "flower04030002001". As seen, when the first memory card is accepted in the system, the reception number at that time is 0000 and the counter increments 0000 by one to have 0001 as the reception number for the first memory card. In

was changed to the incremented file-number.

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order to have the reception number for the second memory card, e.g., 0002, the counter retrieves the previous reception number, e.g., 0001, and increments the previous reception number by one. Thus, the previous reception number, e.g., 0001, as *a last file number of a plurality of reception numbers*, e.g., 0000 and 0001, as *file numbers* is read out and incremented, and these *file numbers* concerning (for) *image files that have been recorded on the second recording medium*, e.g., "flower04030001001" to "flower04030001010", and these *file numbers* are from the second loadable and recording medium. In short, the Shiota discloses the claimed limitation *reading out a last file-number of file-numbers for image files that have been recorded on the second recording medium*);

changing a file name of the image file that has been read out of the first loadable and removable recording medium to the incremented file-number and recording the read image file on the second recording medium (Col. 6, Lines 12-25, *flower0403* as a file name of the image file that has been read out from a memory card as *the first loadable and removable recording medium* is changed to *flower04030002001* as the incremented file-number, and recorded in laboratory system as *the second recording medium*) *without checking for duplicate file names in the second recording medium* (Col. 7, Lines 25-28),

wherein the file name includes numerical characters (Col. 6, Lines 12-25, e.g., *flower0403*).

Shiota fails to disclose the second recording medium is *loadable and removable*. However, Shiota uses a conventional computer as the device for processing image files. The conventional computer as disclosed, obviously, has a loadable and removable recording medium such as floppy disk or CD as disclosed by Ahrens (Ahrens, Page 14). Shiota further makes a strong suggestion, the picture image filing device specifically means, for example a printing system having the above function and set in a laboratory, a personal computer, a work station or the like (Col. 4, lines 1-5). Thus, instead of processing in a hard drive, a loadable and removable

recording medium such as a high capacity disk could be used for storing, e.g., floppy disk or CD.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Shiota device by including a second loadable and removable recording medium when processing the image files from a first storage medium in order to have a more user-friendly environment by giving drive options for storing data such as a displaying of selection including C, A, and E drive to the users when processing the image from a digital camera or a memory card of digital camera.

Regarding claims 8 and 11, Shiota and Ahrens teach all the claimed subject matters as discussed in claims 7 and 10, Shiota further discloses the steps of *grouping image files, which have been recorded on the second loadable and removable recording medium according to the types of images represented by the image files* (Col. 5, line 49-Col. 6, line 7).

Regarding claims 9 and 12, Shiota and Ahrens teach all the claimed subject matters as discussed in claims 8 and 11, Shiota further discloses the step of *recording a file name corresponding to each group on the second loadable and removable recording medium* (Col. 5, line 49-Col. 6, line 7).

Regarding claims 13 and 17, Shiota and Ahrens teach all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses *the file names of the image files in the second loadable and removable recording medium are such that the numerical characters of the file names of the image files are consecutively numbered, wherein a numerical difference between two consecutive numbers is a predetermined amount for all consecutive numbers* (Col. 7, Lines 25-35).

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Regarding claims 14 and 18, Shiota and Ahrens teach all the claim subject matters as discussed above with respect to claims 13 and 17, Shiota further discloses *the numerical characters of the file names of the image files are consecutively numbered regardless even when image files from a plurality of first loadable and removable recording mediums are read out and recorded on the second loadable and removable recording medium* (Col. 7, Lines 25-35).

Regarding claims 15 and 19, Shiota and Ahrens teach all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses *the incrementing device always increments the last file-number by a predetermined amount* (Col. 7, Lines 20-39).

Regarding claims 16 and 20, Shiota and Ahrens teach all the claim subject matters as discussed above with respect to claims 15 and 19, Shiota further discloses *the predetermined amount is 1* (Col. 7, Lines 20-39).

Regarding claims 21 and 22, Shiota and Ahrens teach all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses the step of *directly reading out the files names of the image files recorded on the second loadable and removable recording medium* (Col. 7, Lines 40-46).

Regarding claims 23 and 24, Shiota and Ahrens teach all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses *the numerical characters of the file name is unique to each image file stored in the second loadable and recording medium* (Col. 6, Lines 12-25, *flower0403* as the file name is unique to *flower04030002001* stored laboratory system).

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Regarding claims 25 and 26, Shiota and Ahrens teach all the claim subject matters as discussed above with respect to claims 13 and 17, Shiota further discloses *the predetermined amount is 1* (Col. 7, Lines 20-39).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HUNG Q PHAM
Examiner
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December 21, 2006